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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,196	09/20/2001	William B. Boyle	K35A0977	6651

26332 7590 01/11/2006

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EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,196

Applicant(s)

BOYLE ET AL.

Examiner

Bob Chevalier

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8-10 is/are rejected.
- 7) ☒ Claim(s) 3, 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2, 4-6, 8-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al in view of Miller et al.

Elliot et al discloses a video recording/reproducing apparatus that shows substantially the same limitations recited in claims 1, and 9-10, including the feature of

the digital video recorder for use with a monitor and a set top box, the set top box for demodulating program data by tuning to a least one of a plurality of channels (See Elliot et al's Figure 1), the feature of the set top box including a DVR interface (See Elliot et al's Figure 1, component 130), the feature of the DVR comprises a local memory for storing the program data received from the STB (See the capability of recording video data received from the STB 100 on the recording medium 220 as shown in Elliot et al's Figure 1), and the feature of the STB interface for communicating with the STB over the DVR interface as specified in the present claims 1, and 9-10. (See Elliot et al's Figure 1, components 130, and 210).

Elliot et al fails to specifically disclose the feature of the DVR controller for communicating control data to direct the STB to tune to a selected channel and the feature of receiving channel change event from the STB in connection with the STB changing to the tuned channel as specified in the present claims 1, and 9-10.

Miller et al disclose a method and system for set top box channel state feedback including the feature of the DVR controller for communicating control data to direct the STB to tune to a selected channel and the feature of receiving channel change event from the STB in connection with the STB changing to the tuned channel as specified in the present claims 1, and 9-10. (See Miller et al's page 1, paragraph [0002], line 4, paragraph [0005], and Figure 9).

It would have been obvious to one skilled in the art to modify the Elliot et al's apparatus wherein the DVR provided thereof would incorporate the capability of communicating control data to direct the STB to tune to a selected channel and the

feature of receiving channel change event from the STB in connection with the STB changing to the tuned channel in the same conventional manner as shown by Miller et al. The motivation is to ensure the correct video programming is recorded in the DVR at any desired time as suggested by Miller et al.

With regard to claims 2, 6, and the feature of the channel-change event being received by the DVR after the STB changes the tuned channel as specified thereof is present in the proposed combination of Elliot et al and Miller et al. (See Miller et al's page 1, paragraph [0002], line 4, paragraph [0005], and Figure 1, components 130, and 150 and Figure 9).

With regard to claims 4, 8, the feature of the DVR transmits a control signal to the STB authorizing the STB to change the tuned channel as specified thereof is present in the proposed combination indicated above. (See Miller et al's page 1, paragraph [0002], line 4).

With regard to claim 5, it is noted that all the limitations recited thereof are present in the proposed combination of Elliot et al and Miller et al indicated above, including the feature of the STB including a tuner. (See Elliot et al's Figure 2, component 112).

Claims 3, 7, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

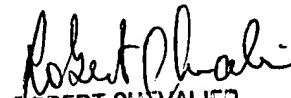
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
January 6, 2006.


ROBERT CHEVALIER
PRIMARY EXAMINER